

Patent Application
U.S. Application No.: 10/777,634
Attorney Docket No.: 52493.000368

REMARKS

The Office Action has been received and carefully considered. Claims 1-20 are pending.
Claims 1, 12 and 18 are amended.

No new matter is added. Support for the amendments to the claims may be found in paragraphs 0017-0020 and 0031-0033 of the published patent application (2005/0182666), for example.

Reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

A. The 35 U.S.C. 112, Second paragraph, Rejection

In the Office Action, claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses such assertion.

The Office Action maintains:

3. Claim 1 recites the limitations, "the rules engine determines whether each of the at least one data element has been fully validated as clean data", "the rules engine generates an exception task if it is determined that at least one data element is not clean", "the rules engine receives a resolution to the exception task, thereby enabling validation of the at least one data element". **All of the above limitations are directed towards method steps of performing the disclosed invention**, however, the other limitations establish a structure which infers that claim 1 is an apparatus. It is unclear as to whether claim 1 discloses a method or an apparatus (*IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005) (MPEP

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

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2173.05(p)). Claims 2-9 fail to cure the deficiencies of claim 1 and incorporate the same rejection and reasoning as claim 1.

(Emphasis added)

The Office Action appears to reject claim 10 on similar basis.

In Applicant's prior Response, Applicant traversed the assertion that "All of the above limitations are directed towards method steps of performing the disclosed invention ...". Claim 1 sets forth various components of the claimed system, as well as processing that is performed by such components. Applicant further amended the claims to clarify that such claim is directed to a system.

In the present Office Action, the Examiner, on page 3, further asserts:

5. To overcome this rejection, Examiner suggest Applicant modify the claim language to recite the claim elements being modified by functional language. For example: --a raw database for electronically storing insurance application related documents;--, --a rules engine configured to determine whether each of the at least one data element has been fully validated as clean data--, etc. Applicant is welcome to call the Examiner for additional clarification.

Applicant appreciates the Examiner's suggestions and comments. However, Applicant maintains that claim 1 sets forth various components of the claimed system, as well as processing that is performed by such components. As to *IPXL Holdings*, Applicant respectfully submits that claim 1 does not recite both a system and a method of using that system so as to be deficient under 35 U.S.C. 112. In short, Applicant respectfully submits that the nature of the claims are more akin to claim 1 of U.S. Patent 6,149,055 (as discussed in the *IPXL Holdings* decision) as opposed to the indefinite claim 25.

Further, Applicant respectfully submits that the Examiner's proposal as set forth in paragraph 5 (excerpted above) essentially invokes 35 U.S.C. 112, sixth paragraph, and/or an interpretation of "intended use." Applicant submits that the present claim language of claim 1

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positively sets forth the processing that is performed by the processing components, in contrast to such invoking of 35 U.S.C. 112, sixth paragraph, and/or "intended use."

Applicant respectfully submits that claim 10 satisfies 35 U.S.C. 112 for similar reasons.

Applicant respectfully requests reconsideration and welcomes discussion of any outstanding concerns of the Examiner which may still remain.

Withdrawal of the 35 U.S.C. 112 rejection is requested.

B. The Rejection of Claims 1, 3-12, and 14-20 under 35 U.S.C. § 103

In the Office Action, claims 1, 3-12, and 14-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,235,654 to Anderson *et al.* ("Anderson") in view of Scanlon (US 5,850,480). This rejection is traversed.

As articulated in the recent Federal Register guidelines:

Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office Action leads to the prompt resolution of issues pertinent to patentability. Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* Federal Register vol. 72, No. 195, Wednesday, October 10, 2007, page 57527.

Applicant respectfully submits that the present rejection fails to articulate sufficient findings of fact to support the 35 U.S.C. 103 rejection. Applicant submits the rejection recites conclusory statements, which cannot sustain an obviousness rejection. See *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Therefore, Applicant respectfully requests that the rejections under 35 U.S.C. 103 be withdrawn.

Applicant's basis for such traversal is set forth below.

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The features of claim 1 are set forth in the listing of claims above. In particular, claim 1 recites:

a rules engine that **converts the documents into at least one data element** having a common format;

the rules engine determines whether each of **the at least one data element** has been fully validated as clean data;

the clean data is stored, by the system, in an operational database for use in application processing;

the rules engine generates an exception task if it is determined that at least one data element is not clean, the rules engine generates an exception task constituted by the rules engine determining a process that is to be performed on the at least one data element that is not clean; and

the rules engine **receives a resolution** to the exception task, upon the performance of the determined process, thereby enabling validation of the at least one data element.

(emphasis added)

As referenced in the Office Action and as set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the **relevant teachings of the prior art relied upon**, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

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M.P.E.P 706.02(j) references the well known requirements of Graham v. John Deere. Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

Applicant submits that such analysis is not satisfied, so as to fairly support the 35 U.S.C. 103 rejection. The basis of the rejection of claim 1 is set forth on pages 4-5 of the Office Action. In particular, the Office Action maintains:

4. As to Claim 1, Anderson teaches a system for routing and processing insurance related data (Anderson, Abstract and col. 8 lines 44-52), the system comprising:
 - a. a raw data database electronically storing insurance application related documents (Anderson, col. 3 line 63 to col. 4 line 19, the Examiner takes the position that the master machine generated data structure is equivalent to the raw data database);
 - b. a rules engine that converts the documents into **at least one data element** having a common format (Anderson, Fig. 4A, Fig. 7A-7E, col. 21 lines 25 to col. 22 line 13);
 - c. the clean data is stored in an operational database for use in application processing (Anderson, col. 3 lines 24-33, col. 33 lines 50-66);
 - d. the rules engine generates an **exception task** if it is determined that **at least one data element is not clean** (Anderson, col. 6 lines 56-63, col. 27, lines 38); and
 - e. the rules engine receives a resolution to the exception task, thereby enabling validation of the **at least one data element** (Anderson, col. 7 lines 2-13).

Anderson does not specifically disclose the rules engine determining whether each of the at least one data element has been fully validated as clean data. **Scanlon does teach the rules engine determining whether each of the at least one data element has been fully validated as clean data** (Scanlon, Figs. 3 and 7E, col. 31 lines 42-48 and col. 33 lines 16-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included fully validating each data element as clean data for the motivation for OCR error correction (Scanlon, Abstract).

(emphasis added)

Claim 1 is further amended to recite further details of the exception task and related processing.

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Applicant maintains that it is unclear what the Office Action interprets as teaching the claimed "exception task." Applicant notes that Anderson describes:

... In performing the character recognition process, the resultant coded data may contain errors which are **analyzed by the artificial intelligence error correction processor 28**, also shown in FIG. 1. The sequence of forms recognition and field extraction, yields the MGDS 50A, as is shown in FIG. 1A. The MGDS 50A is then transferred to the character recognition processor 26, along with the extracted field images 10". ...

(emphasis added)

However, from such disclosure, it is unclear what would constitute the claimed "exception task." Therein, for example, Anderson describes the "resultant coded data may contain errors which are analyzed by the artificial intelligence error correction processor 28..." However, such described analyzing may be performed in any of a wide variety of manners. Such described analysis of Anderson clearly fails to fairly teach the claimed "exception task" - so as to support the 35 U.S.C. 103 rejection.

Applicant notes the related comments on page 15 of the pending Office Action. Therein, the Office Action asserts:

Examiner respectfully disagrees. Applicant is encouraged to review the corresponding disclosure in reference to the artificial intelligence error correction processor. The artificial intelligence error correction processor handles the first repair for data that is determined to contain errors (reads on, "not clean") (col. 27 lines 3-8). Applicant has not provided any controlling definition regarding the claimed element, "exception task", therefore, Examiner applies the broadest reasonable interpretation as to the functionality of the "exception task" in view of the claim language. It is interpreted that the **limitation recites a task** being generated by a rules engine if it is determined that at least one data element is not clean.

(emphasis added)

In response, Applicant acknowledges that the claimed features are open to the broadest reasonable interpretation. However, Applicant respectfully submits that the above assertions, even taken arguendo as true, fails to support the rejection. That is, a "task being generated by a

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rules engine if it is determined that at least one data element is not clean" falls short of teaching the claimed invention - in that such is not associated with a received "resolution" as recited in claim 1.

Also in Applicant's prior Response, Applicant described that claim 1 recites various processing associated with the claimed "at least one data element". The assertions in support of the rejection, as set forth above, allege manipulation by each of Anderson and Scanlon of such "data element." That is, for example, the Office Action asserts that Anderson teaches manipulation of such data element in clauses (b), (d) and (e), as set forth above. Further, the Office Action asserts that "Scanlon does teach the rules engine determining whether each of the at least one data element has been fully validated as clean data."

Thus, the Office Action appears, in such interpretation, to cast both Anderson and Scanlon as teaching such "at least one data element." However, Applicant submits that such interpretation clearly mischaracterizes the applied art and fails to fairly support the 35 U.S.C. 103 rejection. That is, as best understood, the Action appears to be attempting to interpret Anderson's "character" or "character position" as the claimed "data element." (see Anderson in column 7, lines 1-4 and the pending Office Action on page 16, lines 16-17). On the other hand, as best understood, the Office Action appears to be attempting to interpret Scanlon's "sub-string table" as the claimed "data element." (see Scanlon in column 31, lines 42-48 and column 33, lines 16-31).

As can be clearly appreciated, such parameters of Anderson vis-à-vis Scanlon are fundamentally different in nature. As a result, Applicant submits that it is a clear mischaracterization of the teachings (of the applied art) to interpret such parameters as

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constituting the claimed data element. Indeed, it is fully unclear how the described manipulation of Anderson's "character" or "character position" would be combined with the described manipulation of Scanlon's "sub-string table", i.e., so as to be workable in any manner. Indeed, Applicant submits that to talk of such respective parameters of Anderson and Scanlon as akin (to each other) is nonsensical.

In response to such assertions, the pending Office Action, on page 16, asserts:

Again, Examiner must inquire as to the controlling definition of the Applicant's claim element, "data element". The claim language is so broadly written that a "data element" could be read in any number of ways. For example, the limitation reciting, "a rules engine that converts the documents into at least one data element having a common format" could be interpreted as the data application (reads on "rules engine") that converts the documents into character text (reads on "at least one data element") in English (reads on "a common format").

In response, Applicant respectfully submits that such assertions in the Office Action appear misplaced vis-à-vis Applicant's argument. The applied art must be combined in some manner which would have been obvious to the one of ordinary skill. Once combined, the modified teachings must teach the claimed invention. However, in this case, Applicant respectfully submits that it is unclear how the applied art would even be combined - given the fundamentally different nature of the "at least one data element" as set forth in the relied upon teachings of Anderson and Scanlon.

For at least the reasons set forth above, Applicant submits that Anderson fails to support the applied rejection of claim 1 under 35 U.S.C. 102.

Regarding independent claims 10, 12, 18, and 19, since these claims contain similar limitations as argued above with respect to independent claim 1, the same reasons apply to these independent claims.

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For at least these reasons, independent claims 1, 10, 12, 18, and 19, as well as dependent claims 2-9, 11, 13-17, and 20, are patentable over the applied art. Therefore, the undersigned representative will not address the arguments with respect to such dependent claims and reserves the right to address these arguments at a later time. Accordingly, it is respectfully requested that the rejection of claims 1, 3-13, and 14-20 under 35 U.S.C. §103 be reconsidered and withdrawn.

C. The Rejection of Claims 2 and 13 under 35 U.S.C. § 103

In the Office Action, claims 2 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of in view of Scanlon (US 5,850,480) in further view of the Office Action's alleged Applicant Admitted Prior Art (AAPA).

As admitted in the Office Action, Anderson, *inter alia*, does not disclose the common format being extensible Markup Language. Rather the Office Action takes official notice for this element.

Applicant submits that the modification of Anderson, as proposed in the Office Action, fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify Anderson as asserted in the rejection of claims 2 and 13 under 35 U.S.C. 103, which is not admitted by Applicant, such would still fail to fairly teach or suggest the claimed invention.

Since claims 2 and 13 are dependent on allowable claims 1 and 12, respectively, these claims are allowable for the same reasons. Accordingly, it is respectfully requested that the rejection of claims 2 and 13 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

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D. Conclusion

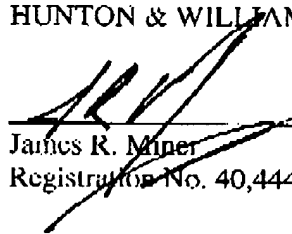
For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

For any fees due in connection with filing this Response the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: **March 9, 2010**


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